REMARKS

The Examiner has revised the current rejection. As set forth below, such new rejection is still deficient. However, despite such deficiencies and in the spirit of expediting the prosecution of the present application, applicant has clarified each of the independent claims. Since the subject matter of such clarifications was already considered by the Examiner, it is asserted that such clarifications would not require new search and/or consideration.

The Examiner has rejected Claims 1-6, 8-10, 12-15, 23-27, 28-30, 32, 34, and 41-44 under 35 U.S.C. 103(a) as being unpatentable over Stewart et al. (U.S. Patent No. 6,901,519) in view of Hargraves et al. (U.S. Provisional Application No. 60/289,814). In addition, the Examiner has rejected Claims 7 and 36-39 under 35 U.S.C. 103(a) as being unpatentable over Stewart, in view of Hargraves, and further in view of Schwabe et al. (U.S. Publication No. 2003/0028686). Applicant respectfully disagrees with such rejections, especially in view of the clarifications made hereinabove to each of the independent claims.

With respect to the independent claims, the Examiner has relied on Col. 5, lines 10-21 from the Hargraves reference to make a prior art showing of applicant's claimed technique "wherein it is determined if the first file format is one of a word processing file format type and a graphics file format type, the second file format being at least one of a TXT file format, a RTF file format without embedded objects, and a HTML file format without scripts if it is determined that the first file format is the word processing file format type" (see this or similar, but not necessarily identical language in the independent claims).

Applicant respectfully notes that the citation in Hargraves noted by the Examiner with respect to the above rejection appears to refer to an excerpt from U.S. Patent No. 6,950,987, issued to Hargraves. However, the disclosure in such excerpt is not included in Hargraves' provisional application (U.S. Provisional Application No. 60/289,814), and

thus cannot receive the benefit of the priority date thereof. Since U.S. Patent No. 6,950,987 to Hargraves was filed after the present application, reliance on the above excerpt is improper.

Additionally, with respect to the independent claims, the Examiner has failed to provide a specific prior art citation to address applicant's claimed technique "wherein it is determined if the first file format is one of a word processing file format type and a graphics file format type... the second file format being at least one of a JPB file format, a BMP file format, a GIF file format, a HTML file format without scripts, and a JPEG file format if it is determined that the first file format is the graphics file format type" (see this or similar, but not necessarily identical language in the independent claims).

Applicant respectfully asserts that none of the prior art reference excerpts relied on by the Examiner to meet the remaining limitations of applicant's independent claims even suggest "the second file format being at least one of a JPB file format, a BMP file format, a GIF file format, a HTML file format without scripts, and a JPEG file format if it is determined that the first file format is the **graphics** file format type," as claimed (emphasis added). Thus, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

In the Office Action mailed 08/20/2008, the Examiner has argued that "[t]he instant claims recite two embodiments" and that "such a conditional recitation requires that only one condition is met, therefore Examiner has relied upon the first conditional embodiment as recited in the claim." Further, the Examiner has "clarifie[d] the reference to the prior art citation which discloses the limitation in the following section of the disclosure (see col. 5, lines 10-21 where Hargraves teaches the first condition of the *if* limitation in the claim- Document 17a such as a Microsoft Word document, is converted to an RTF (ASCII character), as an 'existing other-format document.'"

Applicant respectfully disagrees and notes that applicant claims a technique "wherein it is determined if the first file format is one of a word processing file format type and a graphics file format type" (emphasis added), as claimed. Additionally, applicant clearly claims a technique where "the second file format [is] at least one of a TXT file format, a RTF file format without embedded objects, and a HTML file format without scripts if it is determined that the first file format is the word processing file format type," as well as a technique where "the second file format [is] at least one of a JPB file format, a BMP file format, a GIF file format, a HTML file format without scripts, and a JPEG file format if it is determined that the first file format is the graphics file format type" (emphasis added), as claimed. Therefore, the technique claimed by applicant does not require that only one condition be met, as argued by the Examiner.

Additionally, applicant has demonstrated above how the Examiner's reliance on Col. 5, lines 10-21 from Hargraves is improper, namely since such disclosure is only included in Hargraves' non-provisional patent application which postdates applicant's present application. Therefore, for at least the aforementioned reasons, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck,* 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art excerpts, as relied upon by the

Examiner, fail to teach or suggest all of the claim limitations, as noted above. Therefore, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Nevertheless, despite such paramount deficiencies and in the spirit of expediting the prosecution of the present application, applicant has amended each of the independent claims to further clarify applicant's claim language, as follows:

> "wherein it is determined if the first file format is one of a word processing file format type and a graphics file format type, the second file format being at least one of a TXT file format, a RTF file format without embedded objects, and a HTML file format without scripts [[if]]in response to it [[is]]being determined that the first file format is the word processing file format type, the second file format being at least one of a JPB file format, a BMP file format, a GIF file format, a HTML file format without scripts, and a JPEG file format [[if]]in response to it [[is]]being determined that the first file format is the graphics file format type" (see this or similar, but not necessarily identical language in the independent claims).

To this end, in view of the above clarifications made to the independent claims, applicant respectfully asserts that the Examiner's argument that the "instant claims recite two embodiments" and that "such a conditional recitation requires that only one condition is met" is now moot. Moreover, applicant again notes that the Examiner's reliance on Col. 5, lines 10-21 in Hargraves' is clearly improper.

Again, since at least the third element of the *prima facie* case of obviousness has not been met, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Thus, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1351 (Order No. NAI1P092).

Respectfully submitted,
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